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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91191056
Party	Defendant Franciscan Vineyards, Inc.
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Submission	Motion to Dismiss - Rule 12(b)
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Date	02/12/2010
Attachments	91191056 motion dismiss 2-12.pdf (10 pages)(406240 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

-----X
White Rock Distilleries, Inc.

Opposition No. 91191056

Opposer

Mark: PINNACLES RANCHES

v.

Serial No.: 77/598674

Franciscan Vineyards, Inc.

Applicant

-----X

**APPLICANT'S MOTION TO DISMISS THE OPPOSITION IN ITS ENTIRETY
BASED UPON THE OPPOSER'S FAILURE TO DISCLOSE ANY
INFORMATION OR DOCUMENTS TO SUPPORT ITS CLAIMS**

Applicant, Franciscan Vineyards, Inc., Inc. ("Opposer"), through its undersigned attorneys, respectfully moves this Honorable Board to dismiss the opposition in its entirety based upon the Opposer's failure to disclose any information or documents in support of Opposer's claims. Alternatively, and contingent upon Opposer having any information or documents to be disclosed¹, Applicant moves that Opposer be compelled to serve amended disclosures without reservation or limitation and that Applicant's time to respond to Opposer's discovery requests begin to run from the date of service of Opposer's amended disclosures and that no depositions be noticed by Opposer until the Board rules on this motion.

BACKGROUND

On February 5, 2010, Opposer served Applicant with its so-called Initial Disclosures and its discovery requests. A copy of the "Initial Disclosures" is annexed hereto as Appendix "A".

¹ If Opposer has nothing to disclose concerning its claims, Opposer moves that the Notice of Opposition be dismissed on that basis.

The Notice of Opposition in this matter has two Counts/claims², namely (1) that Applicant's mark is primarily geographically descriptive, and (2) that Applicant's mark fails to function as a mark. Opposer's claims are not made on "information and belief" but rather are directly and specifically averred.

Opposer's Initial Disclosures are limited as follows:

A. Individuals likely to have information – Opposer disclosed two individuals that allegedly have discoverable information limited/restricted to the use of Opposer's own mark (including marketing and advertising efforts and distribution and sales of products under Opposer's own mark).

B. Description of Documents – Opposer identified only two categories of documents, namely (1) documents evidencing Opposer's use of its own mark, including marketing and advertising of goods under its mark, and (2) documents evidencing sales of Opposer's own goods under Opposer's own mark.

While the above disclosures could possibly be construed to support Opposer's alleged standing, the disclosures are not and cannot be construed to disclose persons, information or documents concerning, in any way, Opposer's actual claims set forth in its Notice of Opposition.

ARGUMENT

Rule 26(a)(1) F.R.Civ.P, concerning Initial Disclosures, sets forth what must be provided in complying with the rule. Included are:

(i) the name and, if known, the address and telephone number of each individual likely to have discoverable information — along with the subjects of that information — that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment;

² The original Notice of Opposition contained three Counts, the third Count being a fraud claim. Said fraud Count/claim was dismissed by order of the Board dated November 6, 2009.

(ii) a copy — or a description by category and location — of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment.

[Underlined emphasis added].

As indicated in the Background section above, Opposer's claims set forth in the Notice of Opposition are (1) that Applicant's mark is primarily geographically descriptive, and (2) that the mark fails to function as a mark. As also indicated in the Background section above, and as is clear from the Opposer's Initial Disclosures attached as Appendix "A", there is not a single disclosure going to Opposer's claims. As also indicated in the above Background section above, the averments of the Notice of Opposition are not based upon "information and belief" but are rather direct, specific averments.

Based upon the disclosures/representations made in Opposer's Initial Disclosures and since the Initial Disclosures fail to disclose a single person, document or any information going to Opposer's actual claims, the Board may presume that Opposer has no basis for its claims. Other than the above presumption (i.e., no basis for its claims), there is no excuse for Opposer's failure to disclose anything concerning its claims. As stated in Rule 26(a)(1)(E) F.R.Civ.P. (*Basis for Initial Disclosure; Unacceptable Excuses*): "A party must make its initial disclosures based on the information then reasonably available to it. A party is not excused from making its disclosures because it has not fully investigated the case . . ."

As presented in *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88

USPQ2d 1541, 1543 (TTAB 2008):

The requirement for parties to make reciprocal initial disclosures was introduced into Board inter partes proceedings by amendments to the Trademark Rules, and is applicable to all proceedings which commenced on or after November 1, 2007. *See Notice of Final Rulemaking, Miscellaneous*

Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242 (Aug. 1, 2007), (hereinafter “Final Rule”). In the Final Rule, the Board indicated that the requirement for reciprocal initial disclosures facilitates the exchange of “core information regarding the existence of and location of witnesses and documents,” lessens the expense of traditional discovery, and promotes early communication toward possible settlement. It is clear that the obligation of parties to make initial disclosures is integral to the efficient conduct of Board proceedings and not an obligation to be taken lightly by the parties.

However, the Final Rule also made clear, in various places, that initial disclosures would essentially be treated the same as discovery responses. Final Rule, 72 F.R. at 42246 (“In essence, initial written disclosures and initial disclosures of documents will be treated like responses to discovery requests.”). “A motion to compel is the available remedy when an adversary has failed to make, or has made inadequate, initial disclosures or disclosures of expert testimony. . . . Final Rule, 72 R.R. at 42256.

[Underlined emphasis added].

Treating Opposer’s Initial Disclosures as “discovery responses” (or in this case, non-responses) provides adequate reason to dismiss the opposition for Opposer’s failure to have any basis to its claims³.

Initial Disclosures should not be treated cavalierly. If they are to serve any purpose and remain a part of TTAB practice and procedure, they must be meaningful, and the failure to fully, properly and openly comply should have consequences. As stated by panel judge Rogers in his concurring opinion in *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715 (TTAB 2008) at p. 1729:

All too often in Board cases, information that is clearly relevant to a claim or defense and which should be freely shared, preferably through voluntary disclosures or informal proffers of proof, is instead left to languish in the shadows. It is brought out by a party into the light of day only when an adverse

³ The failure to identify a witness in Initial Disclosures (or to supplement those disclosures to add a witness) can be the basis of sticking the witnesses testimony deposition. See, Jules Jurgensen/Rhapsody Inc. v. Baumberger, 91 USPQ2d 1443, 1444-45 (TTAB 2009).

party asks the right question, at the right time, in the right way, i.e., serves the "right" discovery request.

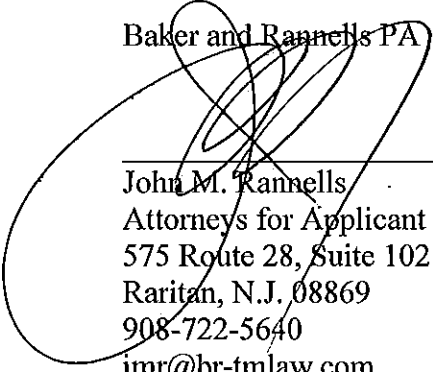
Accordingly, Applicant moves for dismissal of the opposition.

Alternatively, and contingent upon Opposer having any information or documents to be disclosed⁴, Applicant moves as follows:

1. That Opposer be compelled to serve amended disclosures without reservation or limitation;
2. That Applicant's time to respond to Opposer's discovery requests begin to run from the date of service of Opposer's amended disclosures;
3. That Applicant be barred from serving any deposition notices until the Board rules on this motion.

Respectfully submitted,

Baker and Rannells PA



John M. Rannells
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⁴ If Opposer has nothing to disclose concerning its claims, Opposer moves that the Notice of Opposition be dismissed on that basis.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing

**APPLICANT'S MOTION TO DISMISS THE OPPOSITION IN ITS ENTIRETY
BASED UPON THE OPPOSER'S FAILURE TO DISCLOSE ANY
INFORMATION OR DOCUMENTS TO SUPPORT ITS CLAIMS**

has been served via first class mail, postage prepaid, this 12th day of February, 2010 upon
Opposer at the following address of its counsel of record:

Daniel I. Schloss
Greenberg Traurig, LLP
200 Park Avenue, 34th Floor
New York, NY 10166

Dated: February 12, 2010



John M. Rannells

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

-----X
White Rock Distilleries, Inc.

Opposer

v.

Franciscan Vineyards, Inc.

Applicant
-----X

Opposition No. 91191056

Mark: PINNACLES RANCHES

Serial No.: 77/598674

**APPLICANT'S MOTION TO DISMISS THE OPPOSITION IN ITS ENTIRETY
BASED UPON THE OPPOSER'S FAILURE TO DISCLOSE ANY
INFORMATION OR DOCUMENTS TO SUPPORT ITS CLAIMS**

APPENDIX "A"

Opposer's Initial Disclosures

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF APPLICATION

Mark: PINNACLES RANCHES
Applicant: Franciscan Vineyards, Inc.
Serial No.: 77/298,674
Published in
the Official Gazette: March 17, 2009

WHITE ROCK DISTILLERIES, INC.

Opposer,

v.

FRANCISCAN VINEYARDS, INC.,

Applicant.

Opposition No. 91191056

OPPOSER'S INITIAL DISCLOSURES

Opposer White Rock Distilleries, Inc. ("White Rock") hereby submits its initial disclosures pursuant to Fed. R. Civ. P. 26(a)(1) and Trademark Rule §2.120. These disclosures are based upon the information reasonably available to White Rock at this time. By indicating categories of documents or testimony below, White Rock is not representing that it actually has any discoverable documents or testimony that fall within such category(ies). Nothing herein shall be construed as a waiver of the attorney-client privilege and/or work product doctrine. White Rock reserves the right to amend, clarify, or further supplement these disclosures as discovery progresses.

A. Individuals Likely to Have Discoverable Information - Rule 26(a)(1)(A)

Pursuant to FRCP 26(a)(1)(A), White Rock hereby identifies those individuals likely to have relevant discoverable information that White Rock may use to support its claims or defenses:

1. Paul Coulombe, CEO of White Rock Distilleries, Inc.

Subjects: The use of PINNACLE mark and the PINNACLE brand; marketing and advertising efforts in connection therewith.

2. Bill Dabbelt, President of White Rock Distilleries, Inc.

Subjects: Distribution and sales of products sold under Opposer's PINNACLE mark.

Mr. Coulombe and Mr. Dabbelt may be contacted through the undersigned counsel for White Rock. White Rock reserves any and all rights to supplement its list of potential witnesses as appropriate during the course of the proceeding.

B. Description by Category of Documents - Rule 26(a)(1)(B)

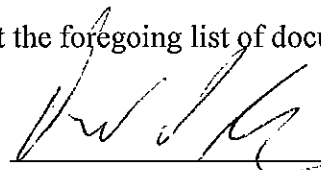
Documents and things that White Rock may use to support its claims include the following, which are located at the office and facilities of White Rock Distilleries, Inc. at 21 Saratoga Street, Lewiston, Maine 04241:

1. Documents evidencing White Rock's use of the PINNACLE Mark, and the marketing and advertising of goods under the PINNACLE Mark;
2. Documents evidencing White Rock's sales of goods under the PINNACLE Mark.

White Rock reserves the right to supplement the foregoing list of documents and things.

Dated: February 5, 2010

By:

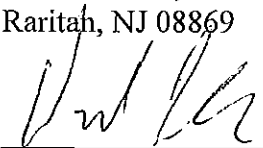

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CERTIFICATE OF SERVICE

Date: February 5, 2010

The undersigned hereby certifies that a true and correct copy of the foregoing Opposer's Initial Disclosures has been served by first class mail, postage prepaid, this 5th day of February 2010 upon Opposer at the following correspondence address of its counsel of record:

Stephen L. Baker, Esq.
Baker & Rannells, PA
575 Route 28, Suite 102
Raritan, NJ 08869


Daniel I. Schloss